

In support of the restriction requirement, the Examiner stated that the two Groups do not relate to a single general inventive concept.

Claim 23 is a product claim, not a process claim as suggested by the Examiner. As mentioned on page 2 of the Office Action, Applicant provisionally elects to prosecute the claims of Group I, with traverse. Applicant affirms the provisional election, but traverses the restriction requirement because the claims of the application do in fact possess unity of invention. Applicant brings to the attention of the Examiner the International Preliminary Examination Report prepared in the international phase of this application. The Examiner who prepared that Report raised no unity of invention objection to the claims. See Box No. 3, item IV, in the Report.

There should also not be an undue burden on the Examiner to examine all claims in one application. For at least these reasons, the restriction requirement should be withdrawn.

## **II. Claim Rejection Under 35 U.S.C. § 102(b)**

The Examiner rejected claims 1-8 and 24-26 under 35 U.S.C. § 102(b) as being anticipated by O'Rourke (U.S. Pat. No. 4,215,152). In support of the rejection, the Examiner states that O'Rourke discloses an instant pudding product comprising starch from 20 to 50% and a water content of 50 to 80% (abstract, col 2, lines 66-68). The Examiner indicates that these ranges are within applicant's instantly claimed range. Additionally, the Examiner notes that the Office does not have the capability to measure the percentage of the broken cells of the vegetable material or measure the amylose particles. The Examiner concludes that the percentage of broken cells and the particles size of the amylose are inherent in the O'Rourke disclosure.

Applicant respectfully traverses this rejection. In order to establish a *prima facie* case of anticipation of these claims, the Examiner must show that the cited reference teaches every element of the applicant's claimed invention. MPEP § 2131. As explained below, however, the cited reference does not teach every element of the invention.

The Examiner stated that O'Rourke discloses an instant pudding product comprising starch from 20 to 50% and a water content of 50 to 80% (abstract, col 2, lines 66-68) which utilizes the same ingredients to form a gel product as the present invention. The text cited by the Examiner actually relates only to the starting slurry, which is then subjected to a treatment in a drum drier, resulting in a product having a moisture content of 2 to 9 %. See O'Rourke at col. 3, lines 3-5. This product is then ground and screened to obtain the instant pudding product. *Id.* at col. 3, lines 6-8.

Nevertheless, O'Rourke does not teach the invention comprising a starchy vegetable material. O'Rourke discloses a product made from starch *per se*, rather than a product made from a starchy vegetable as claimed. The Office does not appear to have recognized this distinction.

In this regard, the O'Rourke Abstract cited by the Examiner refers to a slurry of "ungeletanized starch," rather than to a starchy vegetable material. See *also* col. 4, line 53. The starch *per se* can be derived and separated from various plant products, for example, from tapioca, corn, potato, rice, and amioca. O'Rourke at col. 2, lines 1-3. In contrast, the invention of the examined claims comprises a starchy vegetable material.

The difference between these materials is further highlighted in the examples presented for each invention. O'Rourke discloses the use of tapioca starch in Examples

I and III and amioca starch in Example II. Conversely, the present application discloses, by way of example, a product produced beginning with potato granules. Specification at page 11, line 26. Example starchy vegetables materials are also disclosed at page 5, lines 14-18 of the present application.

Because O'Rourke does not teach the present invention comprising a starchy vegetable material, it also by default cannot teach that at least 50% of the vegetable material's cells are broken as recited in the rejected claims. As mentioned above, the starch disclosed in O'Rourke appears to be extracted from the vegetable material prior to use in the product formation.

O'Rourke also does not disclose that "the amylose of the starchy vegetable material is dispersed into amylose particles under 10  $\mu$ m in size within the amylopectin of the starchy vegetable material" as recited in the rejected claims. To the contrary, in the product of O'Rourke the amylopectin and amylose appear to remain within the starch granule, meaning that the amylopectin and amylose would be unchanged as compared to native starch.

In view of the comments above, the O'Rourke disclosure does not anticipate the rejected claims, either by its express teachings or through inherency. For at least these reasons, the rejection of claims 1-8 and 24-26 should be withdrawn.

Lastly, Applicant disagrees with the Examiner's characterization of the percentage of broken vegetable material cells and the size of amylase particles as "process limitations." Claim 1 is a product claim, not a process claim or a product by process claim. The percentage of broken vegetable material cells and the size of amylase particles are simply structural characteristics of the claimed product.

### **III. Rejection of claims 3-5 and 25-26**

The Examiner provided additional reasons for the rejection of some of the dependent claims. The Examiner states “[w]ith regard to claims 3-5, O’Rourke discloses corn, potato, rice, etc as suitable sources of starch (col 2 lines 1-3). It is well known in the art that potato is a tuberous root and it is inherent that it comprises its entire cell mass.” Additionally, the Examiner notes “[w]ith regard to claims 25-26, O’Rourke discloses corn, potato, rice, etc as suitable source of starch (col 2 lines 1-3). It is inherent that the entire cell mass of peeled potatoes is utilized in order to retain all of the nutrients in the potato.”

As mentioned above, these comments do not appear to have appreciated the difference between the presence of starch *per se* in O’Rourke and the presence of a starchy vegetable material as recited in the rejected claims. The Examiner correctly cites that O’Rourke discloses various vegetables as sources of starch. However, O’Rourke discloses a product made from starch isolated from these sources, rather than made from a starchy vegetable as presently claimed.

### **IV. Rejection of claim 24**

The Examiner cites “[w]ith regard to claims 24, O’Rourke discloses that the starch utilized is ground and screened so that they pass through a 200 mesh U.S. Standard screen and optimally to pass through a 230 mesh U.S. standard screen in order to be suitable for a product such as instant pudding (col 3 lines 6-13). It is inherent that the particle size of the starch is within applicant’s instantly claimed size in order to provide a smooth and non-grainy texture to the product.”